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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,560	05/10/2001	Shinji Okazawa	35.C15511	4024
5514	7590	05/16/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			CHAMPAGNE, DONALD	
			ART UNIT	PAPER NUMBER
			3622	
DATE MAILED: 05/16/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/851,560	OKAZAWA, SHINJI	
	Examiner	Art Unit	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 March 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-36 is/are pending in the application.
 4a) Of the above claim(s) 1-26 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 27-36 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5-26-2004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

1. Applicant's election with traverse of Group B, claims 27-36, is acknowledged. The traversal is on the ground(s) that there would not be an undue burden if the examiner were to examine both groups of claims. This is not found persuasive because, first, the examiner has shown that the two groups of claims constitute distinct inventions under the criteria given by MPEP § 806.05(d). Having done that, the examiner is required to show one of the requirements (A)-(C) given in MPEP § 808.02. The examiner has done that by showing (A), that the inventions defined by the two groups of claims would be separately classified. The requirement is still deemed proper and is therefore made FINAL. Claims 1-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being nonelected.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At line 1, "server" lacks antecedent basis. This rejection can be overcome by replacing said "server" with – method --.
4. Claim 30 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear how "the image information" at line 5 of claim 30 (lines 5-6 of claim 34) relates to "image information" at line 3 of either claim.

Claim Objections

5. Claim 35 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Mere possession of a system capable of performing the method of parent claim 31 would infringe claim 35, but not claim 31. See MPEP § 608.01(n).II and III. Applicant is required to cancel the claim(s) or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 102 and 35 USC § 103

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 27, 31-33, 35 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Meade, II. (US006405214B1).
9. Meade, II teaches (independent claims 27, 31, 35 and 36, and dependent claim 32) a server, method, memory medium and program for managing and discounting the purchase of a consumable, the server comprising: means for identifying the user and a data processing apparatus (*client*, col. 1 line 65 to col. 2 line 14); means for storing and managing *printer use data* (col. 5 lines 7-10), which reads on a result of purchase; means for transmitting information between the *user computer* and a *third-party server/website* (col. 3 line 50 to col. 4 line 17 and col. 5 lines 4-7); and discount information (*discounts*, col. 5 lines 11-18) corresponding to the result of purchase of *toner cartridges*, which reads on each kind of consumable.
10. Meade, II does not explicitly teach means for storing and calculating said discount information. However, since the structure recited in the reference is substantially identical to that of the claims, these claimed properties or functions are presumed to be inherent (MPEP § 2112.01). As evidence tending to show inherency, it is noted that said discount information is *based on the user's actual printing profile* (col. 5 lines 17-18), so said discount

information is inherently variable, which means that it must inherently be calculated by a calculating means. In addition, Meade, II teaches that said discount information originates at a site from which the user printing information has been *uploaded by a third party server* (col. 5 line 14), which reads on the calculating means being a computer, so the discount information must at least be stored in a buffer during the course of processing.

11. Meade, II also teaches at the citations given above claim 33, where the reseller presenting discounts for toner cartridges based on the user's actual printing profile (col. 5 lines 15-18) reads on calculating a demand estimate.
12. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as obvious over Meade, II. Meade, II does not teach that said calculation means is capable of calculating plural discount information for each kind of consumable. Because printers require a plurality of kinds of consumables, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Meade, II that said calculation means be capable of calculating plural discount information for each kind of consumable.
13. Claims 30 and 34 are rejected under 35 U.S.C. 103(a) as obvious over Meade, II in view of Hicks (US006615184B1). Meade, II does not teach transmitting image information (spec. para. [0135] and Fig. 28) with an operation button (button 2808 in spec. Fig. 28) capable of requesting the demand estimate and a results image (spec. Fig. 5-7). Because it would enhance sales to give customers demand estimate results as plots (images), and because buttons are a common means of requesting action on a web page, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Meade, II, that image information be transmitted with an operation button capable of requesting the demand estimate and a results image.

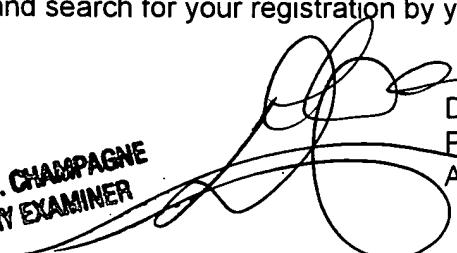
Conclusion

14. The references made of record and not relied upon are considered pertinent to applicant's disclosure. Allen (US006233408B1, col. 6 lines 5-36) teaches some features of the instant invention. Hicks (US006615184B1) teaches image information (Fig. 5) with an operation button (86) capable of requesting discount results as an image (Fig. 6).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
16. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
18. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

10 May 2005

DONALD L. CHAMPAGNE
PRIMARY EXAMINER



Donald L. Champagne
Primary Examiner
Art Unit 3622